

RESPONSE TO EXAMINER'S REJECTIONS/OBJECTIONS

The Applicant has amended Claims 1, 9, 15, 19, 25, 32, 42, 43, 49 and 50 to correct an informality, and as such, amendment is not intended to overcome a rejection. No new subject matter has been added to these amended claims.

Claim Rejections - 35 U.S.C. § 103(a)

Examiner has rejected Claims 1-50 under 35 U.S.C. 103(a) as being unpatentable over D'Urso et al. (US Patent No. 5,353,335) in view of Davitt et al (US Patent No. 5,392,343). Applicants respectfully traverse the examiner's rejections at least for the reasons that follow.

A. There is no motivation to combine

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." As such, the question is whether one of ordinary skill in the art would have been, at the time the invention was conceived, motivated by an implicit or explicit teaching or suggestion found in the prior art to combine the references as combined by the Examiner. Furthermore, the second requirement set by the Federal Circuit mandates that a reasonable expectation of success must also be taught in the prior art.

The Examiner's motivation to combine D'Urso and Davitt is that "to improved [sic] the interpretation service were easier to access and if more people were able to partake of the service." See Office Action, page 3, Line 18-19. It is not clear how introducing Davitt increases the number of people partaking on the service, since the Davitt explicitly excludes any use of cards of any type. In fact Davitt teaches away from cards:

"No extra telephone numbers need to be used and billing for the service may be accomplished without a need for a credit card or a phone card." See Davitt, Column 2, Line 5. Although Davitt does not address interpretation cards, Davitt inf fact teaches away from the use of calling cards. "[T]he requirement that only callers having credit cards or phone cards may use the service unduly limits the number of potential customers for the service." See Davitt, Column 1, Lines 60-64. What is more, Davitt discloses a service that must bill the user for the use of the

service. Specifically, Davitt at Column 5, Line 65 – Column 6, Line 5 states: “The billing for the interpretation services will be added to the billing for the actual telephone call.” Thus, the Davitt system requires billing a user and teaches away from being utilized in conjunction with card systems.

Applicants submit that one of ordinary skill in the art would not have been motivated to combine D’Urso and Davitt in the manner suggested by the Examiner.

B. The hypothetical combination does not teach live language interpretation units

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). The hypothetical combination of D’Urso and Davitt does not teach a predetermined amount of live interpretation units are taught in the cited references.

In the Advisory Action of December 29, 2005, the Examiner states that “the examiner believes D’Urso and Davitt further teaches a service having a predetermined amount of units of live language interpretation service (see D’Urso, fig 1-2, abstract, col.2, line 64 to col.3, line 4, see Davitt, col.1, line 54 to col.2, line 5)”.

Upon closer inspection to the cited references, however, it is apparent that neither D’Urso nor Davitt teach amounts of units of live language interpretation.

Figures 1 and 2 of D’Urso demonstrate a prepaid user 61 in Figure 2. Nothing indicates that units of live language interpretation are available to the prepaid user 61. Furthermore, in the abstract section of D’Urso, a timer is taught as follows: “[a] timer is set with an amount of **calling time** permitted by the available balance.” See D’Urso, Abstract, emphasis added. This section of the abstract of D’Urso discusses an amount of calling time, not units of live language interpretation.

In addition, D'Urso provides a system wherein specific 800 numbers can be provided in a language. The following language of D'Urso has been cited in the Advisory Action to teach predetermined amount of units of live language interpretation service: "To access a telecommunication system in accordance with this invention, a card holder dials a specific toll free number, such as an 800 number, to communicate with the system in his or her language of choice. The card may identify one or more of the possible 800 numbers along with the language associated with the 800 numbers. In one example of the invention, a different card may be sold for each of the languages supported by the system. In this example, only the 800 number for the language of each card needs to be printed on the card. Instructions about how to use the card may be given in that language on the card. The system may support any of a plurality of desired languages such as English, Spanish, French, Japanese, German, Italian, Swedish, Dutch, Korean, Chinese, and other languages." See D'Urso Column 2, Line 64 to Column 3, Line 4. Again, D'Urso does not discuss, suggest or teach live language interpretation units is disclosed.

Finally, the Advisory Action cites language in the Davitt disclosure that not only lacks any reference to predetermined amounts of units of live language interpretation, but also teaches away from any type of predetermined amount units of live language interpretation:

"No extra telephone numbers need to be used and billing for the service may be accomplished without a need for a credit card or a phone card." Column 2, Line 5. Although Davitt does not address interpretation cards, Davitt **teaches away** from the use of calling cards. "Callers having credit cards or phone cards may use the service unduly limits the number of potential customers for the service." See Davitt Column 1, Lines 60-64.

Applicants respectfully request that the Examiner specifically cite the language wherein a predetermined amount of units of live language interpretation service is disclosed. While "an amount of calling time" is disclosed in D'Urso, a predetermine amount of units of live language interpretation service is not found anywhere in D'Urso nor in Davitt (compare for example Claim 1, wherein "predetermined amount of units of live language interpretation service" and "a predetermined amount of telephone service" are claimed).

Conclusion

Therefore, because all the claims limitations are not taught or suggested by Davitt alone or in combination with D'Urso, they cannot be used as the basis of a 103 rejection. Further, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In light of these amendments and arguments, Applicant has overcome the Examiner's 35 U.S.C. §103(a) rejections. Thus, the Examiner is respectfully requested to withdraw these rejections with respect to Claims 1-50.

REMARKS

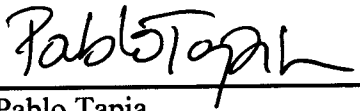
Applicant has complied with all requirements made in the above-referenced communication. In view of the foregoing, it is respectfully submitted that the pending Claims in the application are in condition for allowance. Allowance of the pending claims at an early date is courteously solicited.

If, for any reason, the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicant's undersigned representatives, attention Pablo Tapia at (310) 586-6512 to discuss the steps necessary for placing the application in condition for allowance.

This response is being timely filed and no fee is believed due. However, if Applicant is mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that Attorney Docket Number 53436-014100 is referred to when charging any payments or credits for this case.

Respectfully submitted,

GREENBERG TRAURIG, LLP

By 
Pablo Tapia
Reg. No. 52,275

Date: August 23, 2006

Customer Number 33717
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-6512
Fax: (310) 586-0512
E-mail: tapiap@gtlaw.com
LA 126599052v1 8/17/2006